



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/603,719

06/26/2003

Akira Ariyoshi

204552028700

3281

7590

10/19/2004

Barry E. Bretschneider
Morrison & Foerster LLP
Suite 300
1650 Tysons Boulevard
McLean, VA 22102

EXAMINER

VY, HUNG T

ART UNIT

PAPER NUMBER

2821

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,719

Applicant(s)

ARIYOSHI ET AL.

Examiner

Hung T Vy

Art Unit

2821

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/26/2003</u> . | 6) <input type="checkbox"/> Other: ____ |

Acknowledges

1. Receipt is acknowledged of the following items from the Applicant.

Information Disclosure Statement (IDS) filed on 6/26/2003. The references cited on the PTOL 1449 form have been considered but the examiner has not received the copy of document no. 09-128794 and 2002-056550.

Foreign Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 06/27/2002 and 05/20/2003.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 2821

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and, 10,11 and 19-21 of U.S.

Pending application No.10056255 and claim 1 of U.S. Pending application

No.09907880. Although the conflicting claims are not identical, they are not patentably distinct from each other because all pending applicant have the first and second laser source, wavelength-separating element, first and second holographic element, light receiving element. The following is the table claims of double patenting

10056255	10603719	09907880
1,10,11 and 19-21	1	1

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in present application are similar to claims in co-pending application as shown.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

Art Unit: 2821

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kamiyama J. P. Publication No. 2000-076689 in view of Maruyama et al., U.S. No. 6,785,203.

Claims 1,3, and 8, Kamiyama discloses An optical pickup having a first light source (1,2)(See fig. 11) for generating an optical beam of a first wavelength, second light source (1,2)(See fig. 11) for generating an optical beam of a second wavelength different from the first wavelength, an optical system for converging the optical beams derived from the two light sources onto an optical disk (6)(fig. 11), and a photodetector (14) for detecting reflected light derived from the optical disk (See fig. 11), the optical pickup further comprising: an optical device (24) for separating the light of the first wavelength and the light of the second wavelength reflected by the optical disk from each other (fig. 11); a first hologram device (11) for diffracting the light of the first wavelength separated by the optical device so as to make the light incident on the photodetector (14); and second hologram device (12) for diffracting the light of the second wavelength separated by the optical device so as make the light incident on the photodetector (14), but Kamiyama does not disclose at least one two hologram devices polarization hologram device. However, Maruyama et al. disclose hologram devices porarization hologram device (see column 7, line 60). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Kamiyama to have hologram devices is a polarization hologram device as taught by maruyama et al. The motivation for doing so would have been to provide hologram

devices is a polarization hologram device so that it does not function for the beam directed to the optical disc, reduction of efficiency and generation of stray light can be avoided (see column 7, line 60-63).

Claim 2, Kamiyama discloses the first light source, the second light source, the photodetector, the optical device, the first and second hologram are integrated into one unit (See fig. 11).

Claims 4-7, Maruyama et al. disclose the optical pickup further comprises a $\frac{1}{4}$ wavelength plate (see column 8, line 40), the $\frac{1}{4}$ wavelength plate is adhesively fixed to surface of the composite polarization beam splitter confronting the optical system (See column 7, line 24-26). It would have been obvious that the first hologram and second hologram device are polarization hologram devices with are so set that $\pm 1^{\text{st}}$ order diffraction efficiency of the s-polarized light and 0th order diffraction efficiency because in order to get high efficiency of light go to photodetector. Further, on paragraph 0040-0056, Kamiyama discloses the first hologram and second hologram device are set that $\pm 1^{\text{st}}$.

Claims 9-13, Kamiyama discloses a three-beam diffraction grating is providing between the first, second light sources and the second hologram (See fig. 11), the three beam diffraction grating is wavelength-selective diffraction grating which transmits generally all of the optical beam of the first wavelength and splits the optical beam of the second wavelength into three beam (See fig. 11).

Claims 14-16, Maruyama et al. disclose the photodetector is made up of a plurality of photodetection devices with are arrayed (See fig. 4A).

Claims 17-18, Kaniyama discloses where the first light source is a semiconductor laser of a 650 nm band, and second light source is a semiconductor laser of a 780 nm band (see paragraph 0026) and the first and second source is a high-power laser so as to enable to recording and reproduction onto the optical disk with the high-power laser (see paragraph 0073).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Vy whose telephone number is (571) 272-1954. The examiner can normally be reached on Monday-Friday 8:30 am - 5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-7722 for After Final communications.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either private Pair or Public Pair. Status information for unpublished applications is available through Private Pair only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/603,719

Page 7

Art Unit: 2821

Hung T. Vy

Art Unit 2828

September 21, 2004

A handwritten signature in black ink, appearing to read "Wilson Lee", written in a cursive style.

WILSON LEE
PRIMARY EXAMINER